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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,852	07/22/2003	Eric Lawrence Barsness	ROC920030065US1	6557
30206	7590	05/16/2007		EXAMINER
IBM CORPORATION				MILIA, MARK R
ROCHESTER IP LAW DEPT. 917				
3605 HIGHWAY 52 NORTH			ART UNIT	PAPER NUMBER
ROCHESTER, MN 55901-7829			2625	
			MAIL DATE	DELIVERY MODE
			05/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/624,852	BARSNESS ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Mark R. Milia	2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-22 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 22 July 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### *Drawings*

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) not mentioned in the description: Fig. 3, reference numeral **316**. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

2. The disclosure is objected to because of the following informalities: On page 11, lines 3, 12, and 14, **102** should be **112**. Appropriate correction is required.

3. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code (page 10 lines 5 and 14). Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

***Claim Rejections - 35 USC § 101***

4. Claims 17-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention does not fall within at least one of the four categories of patent eligible subject matter. Claim 17 recites a computer-readable signal bearing media bearing an advertising generator, the advertising generator being a program and the computer-readable signal bearing media being recordable and/or transmission media (see specification page 6 lines 14-15). A signal, which is a form of energy, does not fall within the four categories of patent eligible subject matter. Specifically regarding claim 19, a transmission media transmits signals, such a network or optical cable, which also does not fall within the four categories of patent eligible subject matter. See pages 55-57 of the 101 Interim Guidelines for further clarification.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-18 and 20-22 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,958,821 to McIntyre.

Regarding claim 1, McIntyre discloses an apparatus, comprising: at least one processor (see Figs. 2A and 2B and column 5 lines 12-31), a memory coupled to the at least one processor (see Fig. 4, column 4 lines 1-12, column 5 lines 39-66, and column 8 lines 1-48, reference states that kiosk **170** is an example of an image capable computer **100**, therefore kiosk **170** would also contain the same elements of computer **100**, such as memory, which is also eluded to frequently throughout the reference), at least one digital image residing in the memory (see Fig. 4, column 4 lines 1-12, and column 8 lines 1-48), and an advertising generator residing in the memory and executed by the at least one processor, the advertising generator analyzing a selected digital image for one or more consumer identifying characteristics, and generating an advertisement targeted to a consumer based on the one or more consumer identifying

characteristics (see column 2 lines 22-40, column 8 lines 26-48, 56-59, and 63-65, and column 11 line 57-column 12 line 7).

Regarding claim 10, McIntyre discloses a method for advertising to a consumer based on the content of a digital image associated with the consumer, the method comprising the steps of: analyzing the digital image for one or more consumer identifying characteristics (see column 2 lines 22-40, column 8 lines 26-48, 56-59, and 63-65, and column 11 line 57-column 12 line 7) and generating an advertisement targeted to the consumer based on the one or more consumer identifying characteristics (see column 2 lines 22-40, column 8 lines 26-48, 56-59, and 63-65, and column 11 line 57-column 12 line 7).

Regarding claim 17, McIntyre discloses a program product comprising: an advertising generator that analyzes a selected digital image for one or more consumer identifying characteristics, and generates an advertisement targeted to a consumer based on the one or more consumer identifying characteristics and computer-readable signal bearing media bearing the advertising generator (see column 2 lines 22-40, column 8 lines 26-48, 56-59, and 63-65, and column 11 line 57-column 12 line 7).

Regarding claims 2, 11, 20, McIntyre further discloses wherein the analyzing of the selected digital image for one or more consumer identifying characteristics involves object recognition of at least one defined object within the selected digital image (see column 2 lines 30-36, column 5 lines 39-52, column 8 lines 5-10, and column 9 line 53-column 10 line 6).

Regarding claims 3, 12, and 21, McIntyre further discloses wherein the analyzing of the selected digital image for one or more consumer identifying characteristics involves text recognition within the selected digital image (see column 2 lines 30-36, column 5 lines 39-52, column 8 lines 5-10, and column 9 line 53-column 10 line 6).

Regarding claims 4, 12, and 22, McIntyre further discloses wherein the analyzing of the selected digital image for one or more consumer identifying characteristics involves reading metadata associated with the selected digital image (see column 18 line 57-column 19 line 6).

Regarding claim 5, McIntyre further discloses wherein the apparatus is a photo kiosk (see Fig 2A **170**).

Regarding claim 6, McIntyre further discloses wherein the apparatus is a digital minilab (see column 9 lines 14-30).

Regarding claims 7 and 15, McIntyre further discloses wherein the generated advertisement is a screen display (see Fig. 1).

Regarding claims 8 and 16, McIntyre further discloses wherein the generated advertisement is a coupon (see column 8 lines 63-65).

Regarding claim 9, McIntyre further discloses wherein the generated advertisement is a photo jacket insert (see column 8 lines 40-48).

Regarding claim 14, McIntyre further discloses creating a mapping from one or more potential consumer identifying characteristics to at least one associated advertisement, if at least one consumer identifying characteristic exists within the digital image, identifying at least one associated advertisement to display to the consumer via

the mapping (see column 9 line 53-column 11 line 22, column 13 lines 1-48, column 14 lines 18-38, and column 19 line 24-column 21 line 8) and presenting the at least one associated advertisement to the consumer (see Fig. 1 and column 8 lines 56-59 and 63-65).

Regarding claim 18, McIntyre further discloses wherein the computer-readable signal bearing media comprises recordable media (see Fig. 4).

### ***Conclusion***

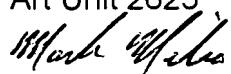
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. To further show the state of the art please refer to the attached Notice of References Cited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark R. Milia whose telephone number is (571) 272-7408. The examiner can normally be reached M-F 8:00am-4:00pm.

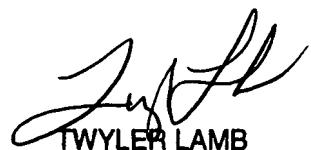
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler M. Lamb can be reached at (571) 272-7406. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mark R. Milia  
Examiner  
Art Unit 2625



MRM



TWYLER LAMB  
SUPERVISORY PATENT EXAMINER